

REMARKS:

In the foregoing amendments, claims 18-23 were added to the application. These claims correspond to previously presented claims 6-11, but include the transitional phrase "consisting essentially of." Accordingly, claims 12-23 are present in the application at this time.

Four independent claims are in the application at this time, which is the same number of independent claims that was considered by the Board. Therefore, no additional fees are believed to be necessary.

As mentioned above, new claims 18-23 use the transitional phrase "consisting essentially of." It is respectfully submitted that this transitional phrase narrows the scope of applicant's claims, so that they are enabled by applicant's specification disclosure and so that applicant's specification disclosure provides a written description of these claims within the meaning of 35 U.S.C. §112. In addition, for the reasons set forth in applicant's brief filed on December 9, 2003, before the Board of Patent Appeals and Interferences (Board) and for the reasons set forth by the Honorable Bradley R. Garriss in his concurrence-in-part and dissent-in part on pages 13-17 in the Decision on Appeal mailed on April 19, 2004, applicant respectfully submits that new claims 18-23 comply with both the enablement and written description requirements of 35 U.S.C. §112. Therefore, an allowance of these claims is respectfully requested.

The Office action set forth a new rejection of applicant's claims 12-17 under 35 U.S.C. §112, first paragraph, as failing to comply with the

enablement requirement. The supporting statements set forth in the Office action for this new rejection can be characterized into two groups of facts or arguments as follows:

(a) Claims 12-14 totally encompass the material claimed in canceled claims 6-11, which were held unpatentable by the Board and claims 15-17 overlap 98% of the material claimed in canceled claim 6-11, which were held unpatentable by the Board. For these reasons, the examiner held that claims 12-17 are based on a disclosure that is not enabling.

(b) There is no mention in the specification of "an average particle size of not more than 320.1 nm," "an average particle size of more than 196.3 nm" or the "surfactant content of no more than 2%" in this specification.

Applicant respectfully traverses this rejection. The examiner's attention is respectfully directed to the Petition under 37 C.F.R. §1.181 to Rescind and Withdraw the Decision of the Technology Center Director Reopening Prosecution of This Application under 37 C.F.R. §1.198 after a Decision by the Board of Patent Appeals and Interferences, which was filed in this application on September 22, 2004. At the time of the filing of this response, a decision was not yet made on this petition. The petition explains the improprieties in the rejection set forth in the outstanding Office action, as well as the reopening of the prosecution in this application after a decision by the Board. It is respectfully requested that the examiner review the petition and remove the rejection of applicant's claims for the reasons set forth therein.

As mentioned above, the petition sets forth many reasons explaining the impropriety of the rejection of applicant's claims, which include at least the following:

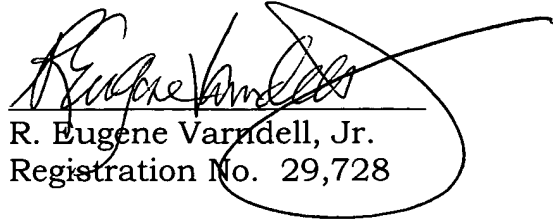
1. The issues set forth in the rejection of claims 12-17 under the first paragraph of 35 U.S.C. §112 were already adjudicated in favor of the applicant. See arguments (B) and (C) on page 6-9 of the petition.
2. The arguments set forth in the rejection are meaningless and irrelevant to the issue of enablement. See argument (D) on pages 9-11 of the petition.
3. The Office action does not set forth a proper rejection under the first paragraph of 35 U.S.C. §112. See argument (E) on pages 11 and 12 of the petition.
4. Applicant's claims 12-17 are enabled by the present specification disclosure within the meaning of 35 U.S.C. §112, first paragraph. See argument (F) on pages 12-15 of the petition.

For the foregoing reasons and those set forth in the petition, a formal allowance of all claims pending in this application is respectfully requested. In the event that the examiner determines that claims 12-17 contain allowable subject matter, but that new claims 18-23 do not, it is respectfully requested that the undersigned be telephoned at the below-listed number to discuss the cancellation of claims 18-23.

While it is believed that the present response places the application in condition for allowance, should the examiner have any comments or questions, it is respectfully requested that the undersigned be telephoned at the below listed number to resolved any outstanding issues.

In the event this paper is not timely filed, applicant hereby petitions for an appropriate extension of time. The fee therefor, as well as any other fees which may become due, may be charged to our deposit account No. 22-0256.

Respectfully submitted,  
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